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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,288	04/08/2004	Rodger P. Grantham	VAP 023 PA	8600
29673 7590 02/21/2007 STEVENS & SHOWALTER LLP 7019 CORPORATE WAY DAYTON, OH 45459-4238			EXAMINER MANCHO, RONNIE M	
			ART UNIT	PAPER NUMBER
			3663	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/21/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/820,288

Applicant(s)

GRANTHAM, RODGER P.

Examiner

Ronnie Mancho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/28/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. .
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 15 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Group (I.) claims 1-4 are drawn to a fuel dispensing system for fueling a vehicle equipped with an ORVR system, classified in class 701/36; 123/519.

Group (II). Claim 15 is drawn to a nozzle configuration compatible with ORVR equipped vehicles, classified in class 141/215, 192, 206.

2. Inventions (I) and (II) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a vapor recovery path extending through said nozzle body. The subcombination has separate utility such as having a vapor recovery path extending through said nozzle body for recovering a vapor.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable

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in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 15 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification/Drawings

3. The specification/drawings received on 2-21-06 have not been entered. The specification/drawings contain new matter as they are related to a complete new and different invention.

4. The amendment filed 2-21-06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In the specification, pages 1, 2, the applicant added the new limitation, "refueling of that are compatible with vehicles having onboard refueling vapor recovery (ORVR). Applicant further changed "recovery" to "refueling", "space" to "space or ullage". By these amendments, the scope of the invention has been changed.

In the specification, page 3, the applicant has replaced a substantial amount of paragraphs 2 and 3 with new limitations that change the scope of the invention.

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The prior art reference cited on page 3, beginning on the last paragraph up to page 5 has been altered.

The whole disclosure has been amended. It therefore will be time consuming to cite all the changes that have been made in the response submitted 2-21-06.

5. The substitute specification filed 2-21-06 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because of the reasons stated above.

Requirements for information.

6. Acknowledgement is made with regard to applicant submission of the prior art that was canceled in the original pages 3, last paragraph to page 5; pages 11-12, etc of the disclosure submitted 2-21-06.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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In amended claim 1, the applicant recites “an area near said end of said spout”; “a first pressure relative to atmospheric pressure”; “fuel blocking at least said second passageway”; “said second passageway is coupled to a vacuum generator within said nozzle”. These limitations were not in the original disclosure.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. In claim 1, the limitation “an area near said end of said spout” is indefinite. It is not understood what all is meant and encompassed by “an area near said end of said spout”.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Healy (6095204).

Regarding claim 1, Healy (figs. 1-7; abstract; cols. 6-12) discloses a fuel dispensing system for refueling a vehicle equipped with an ORVR system wherein said fuel dispensing system includes an assist-type vapor recovery system adapted to transfer vapors expelled from a fuel tank on said vehicle when the said fuel tank is filling with fuel dispensed from an end of a

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spout of a nozzle inserted into a filler tube of said vehicle leading to said fuel tank and said nozzle being coupled to a hose of said fuel dispensing system, said nozzle including an automatic shut-off mechanism for stopping the flow of fuel through said nozzle when said fuel tank is approaching a filled condition, said shut-off mechanism including a diaphragm having a first side and a second side, the improvement comprising:

a first passageway (114, 218) in communication with said first side of said diaphragm 204 and an area near said end of said spout 14 (col. 8, lines 21-67; col. 9, lines 10-50); and

a second passageway (202, 208, 100) in communication with said second side of said diaphragm and an area near said end of said spout 14 (col. 8, lines 21-67; col. 9, lines 10-50);

wherein when the said vehicle is being refilled with fuel from the said fuel dispensing system, pressure relative to atmospheric pressure and generated by the said assist-type vapor recovery system and said ORVR system is communicated to both said first and said the second sides of said diaphragm such that said diaphragm is not substantially deflected by said pressure until such time as the said shut-off mechanism senses said fuel tank approaching the filled condition by fuel blocking at Least said second passageway (col. 8, lines 21-67; col. 9, lines 10-50).

Regarding claim 2, Healy (figs. 1-7; abstract; cols. 6-12) discloses the fuel dispensing system of claim 1 wherein the said first and second passageways are in substantially sealed communication with the said first and second sides of said diaphragm, respectively (col. 8, lines 21-67; col. 9, lines 10-50).

Regarding claim 3, Healy (figs. 1-7; abstract; cols. 6-12) discloses comprising:

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a boot surrounding the said spout and adapted to be in substantially sealed contact with the said filler tube as part of said first passageway (col. 8, lines 21-67; col. 9, lines 10-50).

Regarding claim 4, Healy (figs. 1-7; abstract; cols. 6-12) discloses the fuel dispensing system of claim 1 further wherein said second passageway is coupled to a vacuum generator within said nozzle (col. 8, lines 21-67; col. 9, lines 10-50).

In claims 1, 2, the statement of intended use or field of use, “adapted to”, “substantially”, “wherein when the said vehicle is being refilled with fuel from the said fuel dispensing system, pressure relative to atmospheric pressure and generated by the said assist-type vapor recovery system and said ORVR system is communicated to both said first and said the second sides of said diaphragm such that said diaphragm is not substantially deflected by said pressure until such time as the said shut-off mechanism senses said fuel tank approaching the filled condition by fuel blocking at Least said second passageway” are essentially method limitation or statement of intended or desired use. Thus, the claim as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647. See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Response to Arguments

14. Applicant's arguments filed 12/13/06 have been fully considered but they are not persuasive.

Applicant has canceled claims 1-4 for the purpose of overcoming the rejections above. Applicant further submitted new claim 15. It is a switch of inventions since applicant had originally elected claims 1-4 under the merits for prosecution. Therefore applicant's arguments drawn to claim 15 are moot.

The prior art, Heally disclose a shut-off diaphragm contrary to applicant's argument. The diaphragm in Healy controls vapor flow and to an extent shuts off or reduces or stops the flow of the vapor.

It is believed that the rejections are proper and thus stand.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Communication

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronnie Mancho
Examiner
Art Unit 3663

2/16/07



THOMAS BLACK
SUPERVISORY PATENT EXAMINER